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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,011	02/12/2001	David Leigh Donoho	UNIV0001D2-C	2182

22862 7590 09/21/2005

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EXAMINER

CARDONE, JASON D

ART UNIT	PAPER NUMBER
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2145

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/782,011

Applicant(s)

DONOHO ET AL.

Examiner

Jason D. Cardone

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5,7,9-12 and 14-34 is/are pending in the application.
- 4a) Of the above claim(s) 14-19 and 29-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5,7,9-12 and 20-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to the amendment of the applicant, filed on 7/8/05. Claims 1, 5, 7, 9-12 and 14-34 are presented. Claims 14-19 are withdrawn from further prosecution (See below, Response to Arguments).

Election/Restrictions

2. Newly submitted claims 29-34 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims do not disclose the inspector performs any of mathematico-logical calculations, executes computational algorithms, returns the results of system calls, accesses the contents of storage devices, and queries devices or remote computers. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 29-34 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

3. Claims 1, 5, 7, 9-12 and 20-28 are presented for further prosecution.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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5. Claims 1, 5, 7, 9-12 and 20-28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1,5 and 20-28 disclose an inspector, which includes an inspector library having special purpose executable code. The inspector and the inspector library are not tangibly limited to a physical product. Claims 7 and 9-12 disclose an inspector library containing executable code. The inspector library is not tangibly limited to a physical product. Therefore, claim 1, 5, 7, 9-12 and 20-28 are not tangibly embodied.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

7. Claims 5 and 9 are object to under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 5 and 9 disclose "after a user is made are of what". This statement is not clearly written.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

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patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-14 of USPN 6,879,979 contains every element of claims 1, 5, 7, 9-12 and 20-28 of the instant application and as such anticipates claims 1, 5, 7, 9-12 and 20-28 of the instant application. Claims 1-10 of USPN 6,931,434 contains every element of claims 1, 5, 7, 9-12 and 20-28 of the instant application and as such anticipates claims 1, 5, 7, 9-12 and 20-28 of the instant application. "A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or anticipated by, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " **ELI LILLY AND COMPANY v BARR LABORATORIES, INC.**, United States Court of Appeals for the Federal Circuit, **ON PETITION FOR REHEARING EN BANC** (DECIDED: May 30, 2001).

10. Claims 1, 5, 7, 9-12 and 20-28 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of copending Application No. 09/997,790. Although the conflicting claims are not identical, they are not patentably distinct from each other because they claim the same subject

matter. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1, 5, 7, 9-12 and 20-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Ahmad, USPN 6,029,258.

13. Regarding claim 1, Ahmad discloses a method for inspecting any of the properties of a consumer's computer, the computer's configuration, contents of the computer's storage devices, the computer's peripherals, the computer's environment, or remote affiliated computers, comprising the steps of: providing at least one inspector which includes an inspector library having special purpose executable code [Ahmad, col. 7, line 59 – col. 8, line 26 and col. 10, lines 30-43]; and evaluating subexpressions with the at least one inspector [Ahmad, col. 8, lines 19-26]; wherein the inspector performs any of mathematic-logical calculations, executes computational algorithms, returns the results of system calls, accesses the contents of storage devices, and queries devices [Ahmad, col. 8, lines 27-49 and col. 9, lines 44-63].

14. Regarding claim 5, Ahmad further discloses sending certain relevance clauses to a remote location; evaluating the clauses; and returning the clauses after a user is made aware of what is being transferred; wherein properties of the remote location are learned [Ahmad, col. 6, lines 36-67 and col. 9, lines 44-63].

15. Regarding claims 20-22, Ahmad further discloses the inspector resides at the consumer's computer, wherein invoking the inspector with an advice reader running on the consumer's computer, accessing the special purpose executable code using the advice reader [Ahmad, col. 7, line 59 – col. 8, line 26 and col. 10, lines 30-43].

16. Regarding claim 23, Ahmad further discloses installing at least a portion of contents of the inspector library at run-time [Ahmad, col. 8, lines 3-49].

17. Regarding claims 24-27, Ahmad further discloses delivering advisories from an advice provider to the consumer's based upon results from the at least one inspector, wherein an advice provider delivering information from a plurality of advice providers, wherein information about a consumer does not transfer from the consumer's computer unless the consumer initiates the transfer and dynamically updating a collection of the inspector libraries [Ahmad, col. 7, line 59 – col. 8, line 26, col. 10, lines 30-43 and col. 16, line 52 – col. 17, line 9].

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18. Regarding claim 28, Ahmad further discloses the step of inspecting using the at least one inspector any of: version, operating system, registry, preferences, and a database [Ahmad, col. 9, lines 44-63].

19. Regarding claims 7 and 9-12, claims 7 and 9-12 have similar limitations as claims 1, 5 and 20-28. Therefore, the similar limitations are disclosed under Ahmad for the same reasons set forth in the rejection of claims 1, 5 and 20-28 [Supra 1, 5 and 20-28].

Response to Arguments

20. Applicant's arguments with respect to claims 1, 5, 7, 9-12 and 20-28 have been considered but are moot in view of the new ground(s) of rejection.

21. Applicant's arguments filed 7/8/05 have been fully considered but they are not persuasive toward the restriction.

22. (A) Election requirement and withdrawal of claims 14-19 by the Examiner is deemed to be improper.

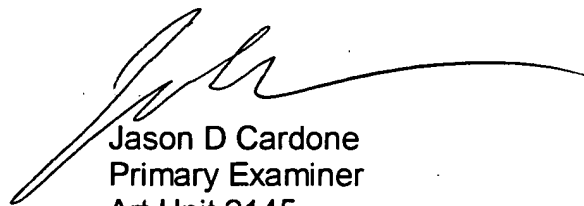
As to point (A), Claims 14-19 disclose inspecting properties of a computer and continually performing relevant determination by evaluating a database of relevant clauses. This is not within the claim language of claim 12. Therefore, the restriction is deemed proper.

Conclusion

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason D. Cardone whose telephone number is (571) 272-3933. The examiner can normally be reached on Mon.-Thu. (6AM-3PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on (571) 272-6159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jason D Cardone
Primary Examiner
Art Unit 2145

September 18, 2005